

REMARKS/ARGUMENTS

Election/Restrictions

The Examiner has withdrawn from consideration Claims 51 - 56 as being directed to an invention that is independent or distinct from the invention originally claimed because they are directed to a non-elected invention. The election was Group I and the species, palm extract, in the reply filed on July 21, 2005.

Applicant disagrees with the Examiner's conclusion since claims 51 - 56 pertain to elected Group I and species – palm extract. Group I is “drawn to a composition comprising annatto extract”. Claims 51 - 56 are annatto extract compositions. Claims 54 and 56 are Markush claims that include the species “palm extract”, which is the elected species. Therefore, claims 51 - 56 are claims within the elected Group I and species – palm extract.

The Examiner is requested to remove the objection to these claims and examine the claims on their merit. Applicant believes Claims 51 - 56 are allowable and respectfully asks the Examiner to allow these claims.

Specification

The Examiner has objected to the amendment filed January 2, 2007 under 35 U.S.C. 132(a) because she alleges that it introduces new matter into the disclosure. She stated “35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: see newly added Table 1.”

The Applicant disagrees with the Examiner that Table 1 enters New Matter, since the contents of this table was supported by the Original disclosure as filed. The Non-Final Rejection does not explain why the cited sections of the MPEP in the Response to the Final Rejection mailed June 3, 2007 is not applicable. All the amendments in the Response mailed on January 2, 2007 are allowed by the MPEP. Applicant requests again an explanation why the cited MPEP sections are not binding decisions.

Not all material added to a Specification is New Matter and there are situations where the addition of material to the Specification is not only allowed but required.

Form Paragraph 6.19 states in part:

“The incorporation of essential material in the specification by reference to an unpublished U.S. application, foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference, if the material is relied upon to overcome any objection, rejection, or other requirement imposed by the Office ...” [emphasis added]

The insertion of Table 1 and the following descriptive paragraph is not New Matter. The MPEP describes several situations where material is allowed to be added to the Specification, and at least one of these situations allows the insertion of Table 1 and the following descriptive paragraph. Three of the justifications for allowing the insertion of material in the Specification are described below.

1. The material was originally in the Patent Application when filed.

Table 1 lists the molecular weights of the various forms of tocopherol and tocotrienol [alpha-, beta-, gamma-, and delta-] disclosed in the application.

Table 1. Molecular weights

	<i>Tocopherol</i>	<i>Tocotrienol</i>
<i>Alpha</i>	430	424
<i>Beta</i>	417	411
<i>Gamma</i>	417	410
<i>Delta</i>	403	396

The “application at filing” included a Preliminary amendment to include the following statement:

“[0002] All publications, patents, patent applications, databases and other references cited in this application, all related applications referenced herein, and all references cited therein, are incorporated by reference in their entirety as if restated here in full and

as if each individual publication, patent, patent application, database or other reference were specifically and individually indicated to be incorporated by reference.”

The pertinent section of the MPEP states:

2163.07(b) Incorporation by Reference

“Instead of repeating some information contained in another document, an application may attempt to incorporate the content of another document or part thereof by reference to the document in the text of the specification. The information incorporated is as much a part of the application as filed as if the text was repeated in the application, and should be treated as part of the text of the application as filed. Replacing the identified material incorporated by reference with the actual text is not new matter. ..” [emphasis added]

Applicant in the Response to the Non-Final Rejection cited the specific document incorporated by reference, and gave the page, paragraph and line for the location of each molecular weight. Merely rephrasing or tabulating of a portion of the specification does not constitute New Matter. Additionally, Applicant submitted an Appendix with the Response that contained a copy of the specific page showing the material incorporated by reference. A copy of each document that was incorporated by reference had been submitted with an IDS and the copies in the Appendix had been obtained from the IFW of the application.

2. The material was inherent

The pertinent section of the MPEP states:

2163.07(a) Inherent Function, Theory, or Advantage

“By disclosing in a patent application a device that inherently performs a function or has a property, operates according to a theory or has an advantage, a patent application necessarily discloses that function, theory or advantage, even though it says nothing explicit concerning it. The application may later be amended to recite the function, theory or advantage without introducing prohibited new matter.“ [emphasis added]

The Specification “as filed” discloses the various forms of tocopherol and tocotrienol [alpha-, beta-, gamma-, and delta-] using standard chemical terminology. The molecular weight

of a chemical is an inherent quality of that chemical, and it is specific and unchanging. For example, if sodium chloride was disclosed, the formula (NaCl) and molecular weight (Na = 23 and Cl = 35) are inherently disclosed by this disclosure.

Therefore, the disclosure of a chemical by use of standard chemical terminology inherently discloses its chemical structure, chemical formula and molecular weight.

3. The material was common knowledge to a person skilled in the arts and its presence was not required by Patent Law.

Form Paragraph 6.02 states in part:

6.02 Content of Specification

(i) DETAILED DESCRIPTION OF THE INVENTION

“...The description should be as short and specific as is necessary to describe the invention adequately and accurately. Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described, and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail.”

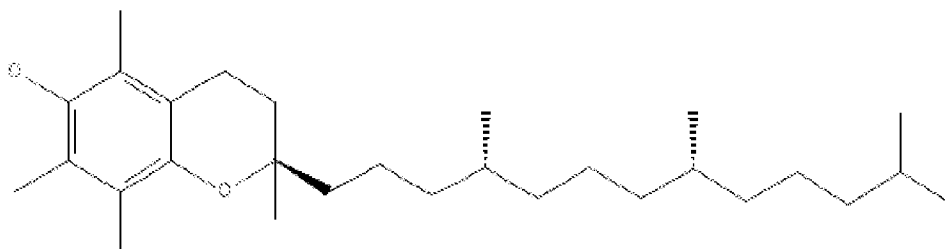
In the Response to the Non-Final Rejection, Applicant submitted a Declaration by Tan to show that a person skilled in the arts would know the molecular weights of the various forms of tocopherol and tocotrienol [alpha-, beta-, gamma-, and delta-] disclosed in the application.

The Tan declaration stated in part:

“.. a person having ordinary skill in the arts would be able to calculate the molecular weights of the isomers of tocopherol and tocotrienol from their chemical structures as: Alpha-Tocopherol = 430, Beta-Tocopherol = 417, Gamma-Tocopherol = 417, Delta-Tocopherol = 403, Alpha-Tocotrienol = 424, Beta-Tocotrienol = 411, Gamma-Tocotrienol = 410, and Delta-Tocotrienol = 396.”

The various forms of tocopherol and tocotrienol disclosed in the application are disclosed using standard chemical terminology. A “person having ordinary skill in the arts” would know both the chemical structure and chemical formula of each form of tocopherol and tocotrienol.

For example, alpha-tocopherol has a chemical structure of



This chemical structure gives the chemical formula of $C_{29}H_{50}O_2$. The molecular weights of Carbon (12), Hydrogen (1) and Oxygen (16) are learned in Grade School and are known by children as young as 10 years old (5th Graders) as can be seen on a current TV Game Show.

The molecular weight of alpha-tocopherol is easy to calculate by simple math. The molecular weight of $C_{29}H_{50}O_2 = (29 * 12) + (50 * 1) + (2 * 16) = 358 + 50 + 32 = 430$.

In light of the foregoing arguments, cited MPEP sections and corresponding Patent Laws, the Examiner is respectfully requested to remove the New Matter objection to Table 1.

In the interests of compact prosecution, in the event the Examiner still believes that Table 1 is New Matter, she is requested to state why the molecular weights in Table 1 are not either present in the Application as filed, inherent qualities of the disclosed various forms of tocopherol and tocotrienol disclosed in the application or common knowledge to a person skilled in the arts.

Claims

35 U.S.C. § 112 Rejections

Claims 39, 47 and 49

The Examiner has rejected Claims 39, 47 and 49 under 35 U.S.C. 112, first paragraph, for failing to comply with the written description requirement. The Examiner has stated “the claims

contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.” Specifically the Examiner has alleged that the recitation “a 350-450 Dalton MW fraction of” in the claims is New Matter.

Applicant disagrees with the Examiner’s conclusion that the phrase “a 350-450 Dalton MW fraction of” in the Claims is New Matter. Applicant has stated above in the discussion concerning the Examiner’s rejection of Table 1 as New Matter, that this material is not New Matter. Applicant has stated at least three reasons why this material is not New Matter. First, the molecular weights of the various forms of tocopherol and tocotrienol were present in the Application as filed; second, the molecular weight of a chemical is an inherent quality of that chemical; and third, the molecular weights of the various forms of tocopherol and tocotrienol are common knowledge to a person skilled in the arts.

In light of the foregoing arguments, cited MPEP sections and corresponding Patent Laws, the Examiner is respectfully requested to remove the New Matter objection and examine Claims 39, 47 and 49 on their merit.

The Examiner was requested in the interests of compact prosecution, in the event the Examiner still believes that the phrase “a 350-450 Dalton MW fraction of” in the claims is New Matter, to state why support for this feature was not either present in the Application as filed, inherent qualities of the disclosed various forms of tocopherol and tocotrienol disclosed in the application or common knowledge to a person skilled in the arts. The Non-Final Rejection did not give an explanation or reasons why the phrase “a 350-450 Dalton MW fraction of” in the claims is New Matter.

Applicant believes Claims 39, 47 and 49 are allowable and respectfully asks the Examiner to allow these claims.

Claims 39 – 41 and 43 - 50

The Examiner has rejected Claims 39 – 41 and 43 - 50 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Examiner has stated that the phrase “a natural extract” is indefinite because it is not clear what is encompassed by this recitation.

The Applicant has amended the claims to include the word “vegetable” as suggested by the Examiner. The Examiner stated on Page 4, line 5 of the Non-Final Rejection mailed July 25, 2007 “applicant has only described vegetable oil”. Therefore, the Examiner has acknowledged “vegetable natural extracts” are supported by the Specification.

In light of the foregoing arguments, the Examiner is respectfully requested to remove the 35 U.S.C. 112, second paragraph, rejection and examine Claims 39 – 41 and 43 - 50 on their merit. Applicant believes Claims 39 – 41 and 43 - 50 are allowable and respectfully asks the Examiner to allow these claims.

Claims 39, 47 and 49

The Examiner has rejected Claims 39 – 41 and 43 - 50 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

The Applicant has amended the claims to include the phrase “in the composition” at the end of the limitation to clearly claim that the limitation pertains to the composition that is the combination of the “oily byproduct extract of *Bixa orellana* seed” and “a 350 - 450 Dalton MW fraction of a vegetable natural extract”.

In light of the foregoing arguments, the Examiner is respectfully requested to remove the 35 U.S.C. 112, second paragraph, rejection and examine Claims 39, 47 and 49 on their merit. Applicant believes Claims 39, 47 and 49 are allowable and respectfully asks the Examiner to allow these claims.

35 U.S.C. §103 Rejections

Claims 1, 25, and 37 - 50

The Examiner has rejected Claims 1, 25, and 37 - 50 under 35 U.S.C. 103(a) as being unpatentable over Tan (US 6,350,453) in view of several secondary citations.

Applicant’s amendments to the claims have obviated these 103(a) rejections.

In light of the foregoing amendments, the Examiner is respectfully requested to remove the 35 U.S.C. 103(a) rejections and examine Claims 1, 25, and 37 - 50 on their merit. Applicant believes Claims 1, 25, and 37 - 50 are allowable and respectfully asks the Examiner to allow these claims.

Conclusion

Claims 1, 25, and 37 - 56 are currently pending. Claims 39, 42, 47, 49, 51, 54 – 56 are Currently amended. Claims 1, 25, 37, 38, 40, 41, 43-46, 48, 50, 52, and 53 are Previously presented. Claims 2-24 and 26-36 are Canceled.

Applicant has endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. Accordingly, amendments to the claims, the reasons therefore, and arguments in support of the patentability of the pending claim set are presented above. In light of the above amendments and remarks, reconsideration and withdrawal of the outstanding rejections is specifically requested and it is respectfully submitted that the present application is in condition for allowance. Should the Examiner have any remaining concerns which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

Extension fees for 2-months are paid with the filing of this Response and no further fees are believed due; however, please charge any additional fees, including any fees for additional extension of time, or credit overpayment to credit card information.

Date December 25, 2007

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